REMARKS

Claims 1-3, 5-12, 14-19 and 36-46 are pending in the subject application. Claims 1, 2, 5, 10-12 and 14 stand rejected. Claims 3, 6-9, 15-19, 42 and 43 have been indicated to contain allowable subject matter.

Applicants wish to thank Examiner James Arnold Jr. and Primary Examiner Walter D. Griffin for the personal interview held on June 17, 2004 with Applicants' attorney Beverly J. Artale, Esq. No agreement was reached during the interview.

DOUBLE PATENTING

Claims 1, 2, 5, 10-12 and 14 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-3, 8-10 and 12 of co-pending Application No. 09/221,539. This rejection is respectfully traversed.

An obviousness-type double patenting rejection rests on the prohibition against issuance of a second patent that would continue protection beyond the expiration of a first patent, where the second patent claims a mere obvious variation of the claims of the first patented invention. The Federal Circuit has held in *In re* Kaplan, 789 F.2d 1,574, 229 USPQ 678 (Fed. Cir. 1986) that obviousness-type double patenting rejections must **include clear and convincing evidence to establish why an alleged variation of an invention claimed in a prior patent (or application in the case of a provisional rejection) would have been obvious.**

To establish a prima facie case of obviousness-type double patenting, the Examiner must identify the inventions claimed in the claims under consideration and in the patent claims, and the Examiner must establish that any variation between the inventions claimed in the claims under consideration and the earlier claims would have been obvious to a person of ordinary skill in the art. In addition, the Federal Circuit has held that he Examiner's showing of obviousness must follow the analysis used to establish a prima facie case of obviousness. See *In re* Longi, 759 F.2d 887, 225 USPQ 645, 651 (Fed. Cir. 1985). Hence, the Examiner has the initial burden to show that the *inventions claimed* are not patentably distinct based on a prima facie

showing of obviousness. A finding by the Examiner that the claims themselves are obvious variations is legally insufficient.

The Examiner has acknowledged that the instant claims are not identical to the claims of co-pending Application No. 09/221,539. To this end, the Examiner notes that the instant claims do not disclose a rare earth component within the pores of the interior pores of the molecular sieve. The Examiner, however, has taken the position that it would have been obvious to one having ordinary skill in the art at the time of the invention was made **not** to utilize the rare earth component in the interior pore structure of the molecular sieve.

The Examiner's position is untenable for several reasons. First, the test for double patenting is whether the later claims define an obvious variation of the earlier claims. In the case at hand, the instant claims have an earlier filing date than the claims of co-pending Application No. 09/221,539. Consequently, the Examiner has improperly rejected the **earlier claims** in view of the **later claims**.

Secondly, the Examiner has suggested that it would have been obvious to the inventor **at the time** of invention of the instant claimed invention not to use or to "delete" the rare earth component claimed in the **later** filed co-pending Application 09/221,539. However, there is no evidence of record which shows the requisite motivation to remove the rare-earth component as claimed in co-pending Application 09/221,539 to derive the invention claimed in the subject application. The only such motivation is found in the claims of the instant application, the reliance on which is impermissible to establish obviousness. Accordingly, the Examiner has failed to establish a prima facie showing that Applicants' invention is obvious over the claims of co-pending Application No. 09/221,539.

Lastly, Applicants wish to remind the Examiner that the only rejections remaining in the instant application and co-pending Application No. 09/221,539 are "provisional" double patenting rejections. Accordingly, MPEP 804.1B requires the Examiner to withdraw the rejection in **the application with the earlier filing date** and permit the application to issue as a patent. As stated earlier, the instant application has the earlier filing date.

For reasons as stated hereinabove, it is believed that the double patenting rejection is improper and should now be withdrawn.

OBJECTION

Claims 3, 6-9, 15-19, 42 and 43 stand objected to as being dependent upon a rejected base claim but would be allowable if re-written in independent form. However, for reasons as stated hereinabove, the subject rejection is improper and should now be withdrawn. Accordingly, Applicants petition for withdrawal of the objection to the claims.

Accordingly, allowance of Claims 1-3, 5-12, 14-19 and 36-43 of the instant application is therefore respectfully requested.

Respectfully submitted,

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